

Remarks

Applicant has amended claims 1 and 10 to particularize the structure of the inventive timber splice and distinguish it from the several devices illustrated in the references cited by the Examiner. The Examiner cites McDearmid as illustrating a cylindrical pipe and having a bar 17, 22 and a first cut (threaded bolts 17, 22) and a similar second cut. The Examiner opines that the bars pass through opposing slots (Figs. 1-2 and page 1, lines 27-75). Careful examination of the reference reveals that the bolts 17, 22 pass through bolt holes 18 and are located in the upper and lower sections of the pipe and the slot 20 is a vertical slot which accommodates a "pin" which is illustrated as a rectangular bar which is driven through one of the piles 16. Careful reference to Applicant's invention reveals that it includes a pair of opposing slots, 16A, 16B through which bar 20 is inserted. The cut ends of bar 20, 34, 36, 44, 46 are effectively tabs which are alternatively bent upwards or downwards to secure the bar 20 intermediate in the pipe 10. Bar 20 is disposed intermediate the respective piles 101, 102 and does not engage the piles in any fashion to secure them in a captive relation, as is the case of pin 19 in McDearmid. In that reference, bolts 17, 22 are additionally inserted through piles 16, 21, (lines 45-48, 57, 59). Therefore, the pile splice of McDearmid is structurally distinct from the splice of Applicant, and there is no correspondence of the claimed elements of Applicant's invention to those recited by Examiner from McDearmid.

Further, there is no correspondence of the claimed upper and lower retaining members 34, 36, 44, 46 of Applicant's invention to the rivet 16, 40, 60 illustrated in Hedstrom. The rivet of Hedstrom is formed of a series of parallel strips or bands which, when the head 16 is struck, the downward inner strands 13, 14, cause the lower legs 17, 18 to spread and form a second head, 17, 18. The Hedstrom device contains no cut or split ends, or any other structure analogous to Applicant's invention, and is intended for no similar use. The Hedstrom device is strictly for securing two plates, 19, 29, 58, 59, 74, 75 together, in parallel relation.

The reference Ferguson reference is cited to show equivalence of the McDearmid/Hedstrom "bar" to the flat configuration illustrated. The bar 10 of Ferguson is fixed to strips 16 such that it cannot be threaded through strips 16 and later secured therein as by use of the split ends of Applicant's invention. There is no comparability in structure or function of the elements of Ferguson to Applicant's invention. Claims 1 and 10 have been amended to more particularly recite the

patentable elements of the invention. For the reasons discussed below, it is respectfully submitted that these claims distinguish the invention over the cited references and therefore, a *prima facie* case of obviousness does not exist.

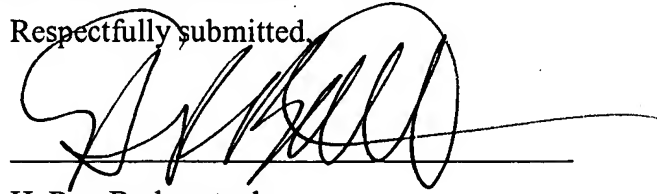
The Examiner bears the initial burden of factually supporting a *prima facie* conclusion of obviousness. MPEP § 2142. If the Examiner does not make out a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. *Id.* To establish a *prima facie* case of obviousness, the Examiner must demonstrate: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings; (2) a reasonable expectation of success; and (3) that the references teach or suggest all of the claim limitations. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not on the applicant's disclosure. *Id.* To support the conclusion that the claimed invention is directed to obvious matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the reference. *Id.*, citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. (1985)).

Applicant has detailed the absence of the claimed elements, and the Examiner has provided no explanation of any teaching or motivation, absent the present application, for combining the references, to the degree that they have been combined to reject the original claims.

Accordingly, Applicant believes that the Application is now in suitable form for allowance and that the rejection of the Examiner based upon the combination of McDermid and Hedstrom, and further in view of Ferguson has been overcome. Reconsideration by the Examiner is respectfully requested and a Notice of Allowance solicited.

If the Examiner feels that a telephone conference with Applicant's attorney would advance the prosecution of the application, he is invited to call the undersigned at 901-537-1108.

Respectfully submitted,



H. Roy Berkenstock
Registration No. 24,719

ENCL.: 1) Amended version of the pending claims

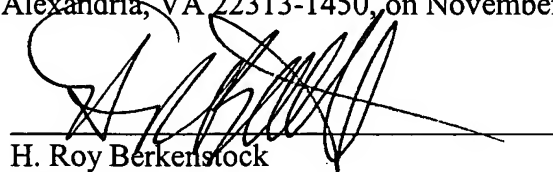
Date: November 9, 2004

WYATT, TARRANT & COMBS, LLP
1715 Aaron Brenner Drive, Suite 800
Memphis, Tennessee 38120-4367

Telephone: (901) 537-1108
Facsimile: (901) 537-1010

CERTIFICATE UNDER 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Mail Stop Non-Fee Amendment, P.O. Box 1450, Alexandria, VA 22313-1450, on November 9, 2004.



H. Roy Berkenstock
Registration No. 24,719

Date: November 9, 2004